

Appln No.: 10/605,862
Amendment Dated: August 28, 2008
Reply to Office Action of May 28, 2008

REMARKS/ARGUMENTS

This is in response to the Office Action mailed May 28, 2008 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Non-elected claims 1-23 have been canceled without prejudice. Claim 69 remains withdrawn. Claim 70 has been added dependent on claim 46, to recite the type of article set forth in claim 69. Applicants point out that claim 70 which is dependent on considered claim 46 has exactly the same scope as withdrawn claim 69. Applicants would prefer to have claim 69 as an independent claim, and therefore request once again that the restriction requirement as to claim 69 be withdrawn, in which case claim 70 will be canceled.

Claims 32, 42, 55 and 65 stand rejected under 35 USC § 112, second paragraph. With respect to claims 42 and 65, the Examiner states that it is not clear what is intended by the term "coloring material." The Examiner suggests that this could be a material that provides superficial color, or a colorimetric indicator. Applicants remind the Examiner that an rejection for lack of definiteness requires some reason why a person skilled in the would be unable to understand the scope of the claim. This has not been done in this case. A coloring material is just that, a material that when added to the polymer composition makes it colored. This is not indefinite.

With respect to claims 32 and 55, the Examiner says that it is not clear what fluorophore will meet the requirements of an "anti-stokes shift dye." He further speculates without any provided reasoning or explanation that there could be anti-stokes shift dyes that will not work. As to the first issue, as stated in the specification, "anti-stokes shift dyes ... absorb in the near infrared wavelength and emit in the visible wavelength." This is a characteristic of the dye, and dyes with this property are known. Thus, a person skilled in the art would be able to determine whether a given dye had this characteristic. As to the speculations about operability, this has nothing to do with a definiteness rejection. If the Examiner wishes to present a rejection under the first paragraph of § 112 in a non-final action, supported by reasoned argument as to the reasons for the Examiner's position as required by *In re Bowen*, 492 F. 2d 859, 181 U.S.P.Q. 48 (C.C.P.A. 1974), Applicants will of course respond.

The Examiner has provisionally rejected claims 24-68 for obviousness-type double patenting in view of any of seven applications. The basis for this provisional rejection is an unexplained assertion that the claims of this application are not patentably distinct from one another. Applicants submit that it is apparent that the Examiner has failed to make a meaningful consideration of these applications, and has apparently cited all applications with some overlap in words and inventors. By way of example, the first application which the examiner cites has having similar but non-identical claims is serial no. 10/605,862. That is the serial number of **this application**. Another of the applications is 11/238,209. This application has issued as US

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Patent No. 7,250,612, and Applicants filed a terminal disclaimer with respect to this patent on 12/18/2007.

The Examiner has not provided any reasoned argument to which Applicants could respond, and has not presented a *prima facie* basis for this rejection. Accordingly, Applicants respectfully request that the Examiner consider the claims of the applications being cited and provide a factual basis for the assertion of obviousness-type double patenting before requiring any response from Applicants.

Claims 24-28, 31, 33, 34, 40-45, 47-51, 54, 56, 57 and 63-68 are rejected as anticipated by US2002/0081714. Of these claims, claim 24 and 47 are independent, and recite a polymer compositions or an article made from the polymer composition. These claims have been amended to refer to a polymeric composition, comprising a polycarbonate polymer and the tagging material as in original claims 39 and 62. Claims 38, 39, 61 and 62 have been canceled. Since claims 39 and 62 were no included in the rejection, this amendment is believed to overcome the rejection.

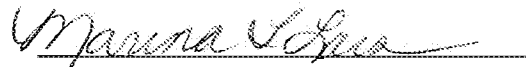
Claims 29, 30, 32, 35-39, 46, 52, 53, 55 and 58-62 were rejected under 35 USC § 103 as obvious over US 2002/0081714. The Examiner argues that the use of any polymer including polycarbonate in place of the "substrate made of a functionalized plastic" would have been obvious. In support of this argument, the Examiner makes no reference to the characteristics of the polymers or their function, but rather cites a case, *In re Leshin*, as evidence that the selection would have been obvious. Applicants submit that the Examiner's reliance on case law for a generalization in place of facts relevant to this invention is in error. *Leshin* does not say that using a known plastic in place of another plastic is always and *per se* obvious. Rather, *Leshin* states that "mere selection of a known plastic ... on the basis of suitability for the intended use" would have been obvious. The examiner has offered no explanation or evidence of consideration of the suitability of polycarbonates for the intended use in the cited reference. The fact that they polycarbonates may be available and have desirable properties does not, without more, make then suitable for the use of the reference. In particular, the substrate of the reference is a "functionalized plastic."

Claims 24 and 47 further contain the limitation that the tagging material is dispersed in the polymeric component. The quantum dots of the reference are disposed on the surface of the substrate and are not dispersed in any part of the substrate. Thus, not matter what polymer the substrate might be made from this aspect of the claim is not met by the reference. Further, changing the reference such that the quantum dots were dispersed in the substrate would render the device inoperative for its intended purpose as a planar array assay.

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For these reasons, Applicants submit that the claims of this application are in form for allowance over the cited art. Favorable reconsideration and allowance of all claims are respectfully urged.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marina T. Larson", is written over a horizontal line.

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